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09/163,588	09/30/1998	MARTIN KELLY JONES	050701-1028	1125

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EXAMINER

LOUIS JACQUES, JACQUES H

ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 09/163,588
Filing Date: September 30, 1998
Appellant(s): JONES, MARTIN KELLY

MAILED

MAR 12 2002

GROUP 3600

Charles W. Griggers
(Reg. No. 47,283)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 23, 2002.

Art Unit: 3661

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-11, 13-14, 16-23, 27-32, 35-39 and 41-55 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

5,648,770	ROSS	07-1997
5,168,451	BOLGER	12-1992

(10) Grounds of Rejection

Claims 1-11, 13-14, 16-23, 27-32, 35-39 and 41-55 are rejected under 35 U.S.C. 103(a) and obvious-type double patenting. These rejections are set forth in prior Office Action, Paper No. 20 (Final Rejection Office Action).

(11) Response to Argument

It is noted that, although appellant argued the double patenting rejections on page 35, such rejections are not mentioned as "issues on appeal". See "**ISSUES**".

Related to issues under group 1 (page 3) and group 2 (page 9), Appellant argued that "[T]he fact that an application has named a different inventive entity than a patent does not *necessarily* make that patent prior art.", citing *Applied Materials Inc. v. Gemini Research Corp.*, 15 U.P.Q.2d 1816, 1818 (Fed. Cir. 1988). Appellant further contended that "[A]n applicant's own work, even though publicly disclosed prior to his applicant, *may* not be used against him as a reference, absent the existence of a time bar to his application", citing *In re DeBaun*, 214 U.S.P.Q. 933, 935 (C.C.P.A. 1982). Emphasis added.

Appellant is correct on both counts. However, this is not the case in this appeal.

In Appellant's arguments quoted above, the key words are "necessarily" and "may". Although, applicant's statement is true, it is not so at all times and in all situations.

The present application was on filed on September 30, 1998 as a continuation of US application 08/852,119 filed on May 6, 1997. The present application names only one inventor, Martin Kelly Jones and is assigned to Global Research System, Inc.

The claims of the present application are rejected as being anticipated US Patent 5,564,770 issued to John Ross. The '770 patent names only inventor, John Ross, and is assigned to Worldwide Notification Systems, Inc.

US Patent 5,648,770 issued on July 15, 1997, is a continuation of US patent application 08/307,032, which matured as US patent 5,444,44, and which in turn is a continuation of US application 08/062,405, filed on May 14, 1993 which is now abandoned. Thus, the '770 patent has an effective filing data of May 14, 1993.

In reference to Applied Material Inc. v Gemini Research¹, the examiner agrees. However, if the patent has an earlier US effective filing date than the application, such patent is considered to be prior art. In the present case, the present application as filing date of May 6, 1997, while the prior art references have an effective US filing date of may 14, 1993.

The situation in In re DeBaun only applies to the same applicant for the patent and the application. By same applicant, it's meant the same inventive entity. In the present case, the present application names only Martin Kelly Jones, while the applied patents name only John Ross.

As to In re Mathews, one major difference between the present applicant and the In re Mathews' case is that Dewey and Mathews were co-workers. In the present case, there is no showing (other than applicant's statement) that applicant and Ross were co-workers. In fact, let it be known that the US patents to Ross, which named only one inventor, Mr. John Ross, are assigned to Worldwide Notification Systems, Inc. and the present application, which names only one inventor, Mr. Martin Kelly Jones, is assigned to Global Research systems, Inc.

On page 6 of the response, Appellant contended "there is no mention of a requirement in *Land* that an applicant be named inventor of a prior patent to overcome the prior patent as a reference." While this may be true, it must clear of record that the patent application and the prior art reference is commonly owned or assigned. Which is not the case in the present situation. Not only the present application and the prior art reference name different inventors and different inventive entities, they are not commonly owned or assigned.

Appellant made same argument relying on the MPEP by stating that there is no requirement in MPEP 2136.05 for the applicant be named as an inventor in the prior US patent. Appellant asserted "there is nothing in the case law or the M.P.E.P. that requires an applicant to show an admission from the inventor or owner of a patent in order to overcome the patent pursuant to DeBaun, and M.P.E.P. 2136.05". While this may be true, the MEPE states that "The fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art." *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 15 USPQ2d 1816 (Fed. Cir. 1988). However, the

MPEP continues by stating “[T]he issue turns on what the evidence of record shows as to who invented the subject matter.” Furthermore, the MPEP states “applicant may overcome a prima facie case based on the patent by showing that the patent disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee was associated with applicant (e.g. *worked for the same company*) and learned of applicant's invention from applicant.” In the case of *In re Land and Rogers* used by applicant, it is noted that *the inventors worked for the same company (Polaroid) and in the same laboratory*. Even they worked for the same company, as the MPEP mentions, “The court affirmed the rejection because (1) the inventive entities of the patents (one to Rogers and one to Land) were different from the inventive entity of the joint application (Rogers and Land) and (2) Land and Rogers brought their knowledge of their individual work with them when they made the joint invention. *There was no indication that the portions of the references relied on disclosed anything they did jointly. Neither was there any showing that what they did jointly was done before the filing of the reference patent applications.*”

While MPEP 2136.05 does not mention that the applicant has to be named as an inventor in a prior US Patent to remove this reference as prior art by an affidavit/declaration, MPEP 715 only refers to “joint application or patent” or “commonly owned application or patent.”

Finally, as stated in MPEP 716, “It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under 37 CFR

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1.132 for the purpose of traversing grounds of rejection are responsive to the rejection and present sufficient facts to overcome the rejection.”

Accordingly, the rejections of claims 1-11,13,14,16-23,27-32,35-39 and 41-55 are sustained.

Applicant submitted a plurality of exhibits in support to show that the subject matter disclosed by Ross and used in the office action to reject the claims is the product of applicant's own previous work. Applicant then asserts that the Ross patent is not prior art. The mere fact that applicant has submitted several exhibits including a declaration filed by applicant stating that applicant is a "co-inventor" of the patents to Ross and that applicant invented the subject matter disclosed in the patents to Ross, is not a basis to remove the Ross patents as prior art and withdrawn the rejections.

The examiner has considered and reviewed all the documents (exhibits) presented before him. However, based on the limited information presented herein, the examiner is not able to make a decision as to withdrawn the rejections. Applicant would need a disclaimer from Mr. Ross and/or the assignee of the Ross patents affirming that applicant's statement is true or any other evidence showing such.

In regard to the double patenting rejections, appellant asserted that “pursuant to 5 U.S.C 154, any patent that will issue from the present application will have a term that will not exceed any of the terms of the foregoing patents, and as a result, there should be no unjustified term extension on a “right to exclude” that is already granted in any of the aforementioned patents.” Accordingly, appellant “requests that the double patenting rejections be withdrawn”.

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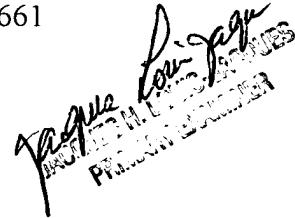
The mere fact two patents or a patent and an application may have a term that will not exceed any of the terms of each other, is not a basis for not submitting a terminal disclaimer to overcome a double patent rejection.

The purpose of a double patenting rejection is not only a means "as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent", but also "to prevent possible harassment by multiple assignees." In light of the foregoing, the double patenting rejection is appropriate.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jacques H. Louis-Jacques
Primary Examiner
Art Unit 3661



/jlj
March 11, 2002

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